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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,385	07/01/2003	Stephen W. Downing	UOMB-001DIV	9385
24353 7590 01/21/2009 BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303				
EXAMINER				
NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
01/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/609,385

**Applicant(s)**

DOWNING, STEPHEN W.

**Examiner**

Victor X. Nguyen

**Art Unit**

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over St. Goar et al (6,629,534) in view of Wilson et al (5,573,515).

Goar et al disclose in figures 81,82 and abstract, a system for performing annuloplasty, including: a plurality of staples (540) is suitable for application to a mitral valve annulus (see col. 40, lines 5-19), a suture 542 is able to staple to a mitral valve annulus along the suture to plicate mitral valve annulus which is able to reduce the length of the valve annulus, where the staples are adapted to deliver to the mitral valve annulus while the heart is beating (see col.6, lines 17-20 and lines 47-52), and where the system further comprises an instrument 562 for delivering the staples to the valve annulus and placating the valve annulus, where the system also comprises a port 500 see fig. 78 adapted to span an atrium and a staple 540 which passes through the port, where the system further has at least one valve at section C in fig. 18 which also has an inlet locates to inferior of element 621, and where the housing has first and second retainer members which are described as annular flanges at best seen in fig. 85. St. Goar is silent regarding a fluid transport device having one end that attaches to the inlet port, another end that attaches to a fluid source, and a fluid channel therebetween to pass a fluid from the fluid source to the inlet as

recited. Wilson teaches a fluid transport device such as a catheter (fig. 1, element 30) having one end that attaches to the inlet port, another end that attaches to a fluid source, and a fluid channel there between to pass a fluid from the fluid source to the inlet.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the system St. Goar to include a fluid transport device having one end that attaches to the inlet port, another end that attaches to a fluid source, and a fluid channel therebetween to pass a fluid from the fluid source to the inlet of Wilson in order to advantageously control which of the fluids will flow into the valve mechanism and out to the catheter within the patient (see col. 3, lines 20-36). The examiner notes that the limitation "a fluid transport device... has another end that is configured to insert into an artery of the patient to permit passage of arterial blood through the fluid channel...whereby the fluid passes from the inlet through the inlet passage and through the lumen into the heart chamber to maintain an intra chamber pressure at a desired level" (an intended used limitation): a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. (See MPEP 2106).

### ***Response to Arguments***

2. Applicant's arguments filed 10/09/2008 have been fully considered but they are not persuasive. In response to applicant's argument that Wilson et al. is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order

to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Wilson teaches a fluid transport device such as a catheter, see fig. 1, element 30, and claims 1-2 of Wilson further define "an apparatus for delivering medical fluid from a fluid reservoir to a patient, while claim 2 recites a patient port for fluid connection to a patient, and col. 3, lines 20-36. Therefore, Wilson's transport device 30 has the same intended use with applicant's transport device to pass fluid from the fluid source to the inlet. Furthermore, the fact that applicant intends to use the system" a fluid transport device... has another end that is configured to insert into an artery of the patient to permit passage of arterial blood through the fluid channel...whereby the fluid passes from the inlet through the inlet passage and through the lumen into the heart chamber to maintain an intra chamber pressure at a desired level" (**an intended used limitation**) does not prevent any other device with the combination of St. Goar in view of Wilson (see the above rejection) from being capable of being used as claimed: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. (See MPEP 2106).

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3734

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Victor X Nguyen/  
Examiner  
Art Unit 3734

VN